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Response to Office Action Dated 01/12/2005

REMARKS

1 A review of the claims indicates claims 1-13, 15 and 17-22 are in original
2 form, and claims 14 and 16 are currently amended. In view of the following
3 remarks, Applicant respectfully requests reconsideration of the rejected claims.
4

35 U.S.C. §102 Rejections

5
6 Applicant submits that the Office has failed to establish a *prima facie* case
7 of anticipation and respectfully traverses the Office's rejections. However, before
8 discussing the substance of the Office's rejections, a section entitled "The §102
9 Standard" is provided and will be used in addressing the Office's rejections.
10 Following this section, a section entitled "The Hanagami Reference" is provided,
11 which describes Hanagami's disclosure and teachings.
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The §102 Standard

16 According to the MPEP §2131, a claim is anticipated only if each and every
17 element as set forth in the claim is found, either expressly or inherently described,
18 in a single prior art reference. The identical invention must be shown in as
19 complete detail as is contained in the claim.
20

21 Anticipation is a legal term of art. The applicant notes that in order to
22 provide a valid finding of anticipation, several conditions must be met: (i) the
23 reference must include every element of the claim within the four corners of the
24 reference (see MPEP §2121); (ii) the elements must be set forth as they are recited
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1 in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be
2 modified (see MPEP §706.02, stating that "No question of obviousness is present"
3 in conjunction with anticipation); and (iv) the reference must enable the invention
4 as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions
5 must be simultaneously satisfied.

6 The §102 rejection of claims 1-3 and 9-20 is believed to be in error.
7 Specifically, the PTO and Federal Circuit provide that §102 anticipation
8 requires that each and every element of the claimed invention be disclosed
9 in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655
10 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited
11 §102 reference of any claimed element negates the anticipation. *Kloster*
12 *Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81
13 (Fed. Cir. 1986).

14 The applicant notes the requirements of MPEP §2131, which states
15 "to anticipate a claim, the reference must teach every element of the claim."
16 This MPEP section further states that "'A claim is anticipated only if each
17 and every element as set forth in the claim is found, either expressly or
18 inherently described, in a single prior art reference.' *Verdegaal Bros. v.*
19 *Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053
20 (Fed. Cir. 1987). 'The identical invention must be shown in as complete
21 detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868
22 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements
23 must be arranged as required by the claim, but this is not an *ipsissimis verbis*
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1 test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831,
2 15 USPQ2d 1566 (Fed. Cir. 1990)."

3 The Hanagami Reference

4 The Hanagami reference discloses a video processing apparatus that
5 prints a picture having an arbitrarily selected size without forging an original
6 picture. That is, Hanagami discloses a way to print a photo of the selected
7 size by using video data in such a way that interpolation-type processes are
8 not required. Thus, the printed photo is more accurate, not resulting from
9 data produced by "decimating processing" (e.g. interpolation). (See
10 Hanagami, Abstract.)
11

12 In operation, Hanagami allows the user to select an arbitrary print size
13 using a selecting means 51, and to adjust a picture frame accordingly (see
14 FIG. 2). The selected picture size may be manually input by entering X- and
15 Y-coordinate dimensions (col. 8, lines 30-35) or may be selected from
16 among sizes associated with required passport photo dimensions of different
17 countries (col. 8, lines 36-43).
18

19 It is a significant core aspect of Hanagami that a CPU 43 is
20 configured to determine the number of pixels of a video data corresponding
21 to the selected print size. Additionally, a memory controller 33 is
22 configured to process the video data so that the number of pixels of video
23 data output from a camera is in one-to-one correspondence with pixels of a
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1 video data to be printed by the printer. (See the Abstract and other
2 locations.)

3 Significantly, Hanagami has discovered how to control aspects of
4 reading video data to result in the desired one-to-one correspondence. (See
5 column 19, lines 36-49.) In large part, Hanagami controls the read sampling
6 frequency (column 19, line 59 to column 20, line 34) in conjunction with
7 aspects of the paper feed pitch (column 19, line 61) to correspond the video
8 data to the print size.

9 Thus, having picked the size of the printed image (typically by
10 entering the size directly or picking the required passport photo size of the
11 appropriate country) the video data is processed by Hanagami's disclosure
12 so that a one-to-one correspondence between pixels of a video data and the
13 data sent to the printer. Accordingly, Hanagami avoids distortion of
14 interpolation and similar processes wherein data may be "forged"
15 (Hanagami's term) to fit the desired picture size. (See Hanagami, Abstract
16 and other locations.)

17 It is instructive to note that the Applicant's claims recite "receiving an
18 image" and "calculating a range of images sizes." In contrast, Hanagami
19 starts by arbitrarily selecting the image size (Abstract, line 3), and then
20 "controls the read sampling frequency" "in response to the print size
21 selected" (column 20, lines 2-4) to get the "one-to-one" pixel
22 "correspondence" (column 19, line 45). Thus, Hanagami goes in reverse—
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1 starting with the image size, and then controlling sampling frequency to
2 adjust data to correspond to that image size.

3
4 **Traversal of the §102 Rejections**

5 Claims 1-3 and 9-20 were rejected under §102 as being anticipated by U.S.
6 Patent No. 6,687,020, hereinafter "Hanagami." In response, the Applicant
7 respectfully traverses the rejection.

8 **Claim 1** recites method for selecting a printed image size comprising steps
9 of:
10

- 11
 - receiving an image;
 - 12 • calculating a range of image sizes for printing said image based
on a plurality of factors; and
 - 13 • selecting at least one of said image sizes in said range for printing
said image.

14

15 **Claim 18** is similar.

16 Hanagami allows the user to select a size of the image by direct means (e.g.
17 entering the X and Y millimeters (col. 8, lines 31-35)) or indirectly (e.g. choosing
18 a country, and automatically getting that country's passport photo size (col. 8,
19 lines 37-43).

20 Having selected the image size, Hanagami applies a controller to the reader
21 of the video source data to control the read sampling frequency and paper feed
22 pitch to result in a one-to-one pixel correspondence (col. 19, line 45 and also col.
23 20 lines 7, 20 and 34).

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1 Thus, Hanagami does not calculate "a range of image sizes," and he does
2 not do this "based on a plurality of factors." Rather than perform a calculation,
3 Hanagami allows the user to select the desired image size (e.g. U.S. passport size).
4 No calculation is performed.

5 Hanagami does not calculate a range of image sizes. In fact, Hanagami
6 selects, rather than calculates, a single desire image size. E.g. the required size for
7 a Japanese or American passport, or a driver's license. Having done so, Hanagami
8 performs the core ideas of his disclosure, i.e. obtaining video data having a one-to-
9 one relationship with the pixels of the selected image size.

10 Not only is the selection done without calculation, but it is done without
11 calculation based on a plurality of factors. No factors for any calculation are
12 enumerated in the recited passage in Hanagami. Accordingly, Hanagami does not
13 disclose "calculating a range of image sizes for printing said image based on a
14 plurality of factors."

15 The Patent Office suggests that Hanagami discloses the recited elements.
16 The Applicant respectfully disagrees.

17 In fact, Hanagami discloses selecting the image size without calculation
18 and without calculation based on a plurality of factors. Additionally, Hanagami
19 discloses selection of a single image size, rather than calculation of a range of
20 image sizes.

21 The Patent Office has pointed generally at column 6, line 27 to column 8,
22 line 53 and column 19, line 59 to column 20, line 34, without showing a specific
23 correlation between aspects of Hanagami's disclosure and the recited elements of
24 the claims. If the Patent Office persists in this rejection, the Applicant respectfully
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1 requests that the Patent Office disclose with more specificity the assumed
2 similarities.

3 Therefore, Hanagami is deficient, and fails to disclose the elements recited
4 by the Applicant's claims. Accordingly, the Applicant respectfully requests that
5 the rejection of claims 1 and 18 be removed, and that these claims be allowed to
6 issue.

7 Claim 2 recites the method of claim 1, further comprising:

- 8
- 9 • receiving a user-preferred image size;
 - 10 • determining whether said user-preferred image size is within
11 said range.

12 Claims 13 and 19 are similar.

13 Hanagami does not disclose a step wherein a determination is made if the
14 user-preferred image size is within the range. This is because (1) Hanagami does
15 not disclose calculating image sizes, or (2) a range of images sizes. Instead,
16 Hanagami allows any arbitrarily-sized image to be selected (Abstract, line 2).
17 Thus, no "determining" step is required. In Hanagami, the user simply selects the
18 size of the image. Therefore, since any size of image may be selected (and the
19 size entered in millimeters, for example, col. 8, lines 30-35) there is no need to
20 determine if it is within a range.

21 The Patent Office suggests that Hanagami discloses in column 6, line 27 to
22 column 8, line 53 and column 19, line 59 to column 20, line 34 the "receiving"
23 and the "determining" steps. However, the Applicant respectfully disagrees.
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1 The Hanagami reference discloses allowing the user to select an image of
2 arbitrary size. Accordingly, Hanagami has no need of, and makes no disclosure
3 of, determining if the selected image size is within a range.

4 Accordingly, the Applicant respectfully requests that the rejection of claims
5 2, 13 and 19 be removed, and that these claims be allowed to issue.

6 **Claim 3** recites method of claim 2, wherein said step of selecting further
7 comprises steps of:

- 8 • selecting said user-preferred image size for printing said image in
9 response to said user-preferred image size being within said range;
10 and
- 11 • selecting said at least one of said image sizes in said range for
12 printing said image in response to said user-preferred image size
13 falling outside of said range.

14 **Claims 14 and 20** are similar.

15 Hanagami does not disclose a step of selecting an image size from a range,
16 among other reasons, because Hanagami allows the selection of any arbitrarily
17 sized image. Accordingly, Hanagami does not disclose the two alternatives
18 recited by claim 3: wherein the image is within the range (paragraph 1 of claim 3)
19 and is not within the range (paragraph 2 of claim 3).

20 The Patent Office suggests that Hanagami discloses in column 6, line 27 to
21 column 8, line 53 and column 19, line 59 to column 20, line 34 the two
22 alternatives presented in claim 3. The Applicant respectfully disagrees, and also
23 respectfully requests that the Patent Office show the location of the two
24 alternatives with more specificity.
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1 Because the two alternatives of claim 3 do not appear to be disclosed by
2 Hanagami, the Applicant respectfully requests that the rejection of claims 3, 14
3 and 20 be removed, and that these claims be allowed to issue.

4 **Claim 9** recites method of claim 1, wherein:

- 5
- 6 • said plurality of factors includes one or more of resolution, aspect
7 ratio, number of pixels per inch of a printed image, and image
8 orientation.

8 **Claim 15** is similar.

9 Hanagami does not disclose a step of "calculating a range of image sizes for
10 printing said image based on a plurality of factors" enumerated in claim 1.
11 Instead, Hanagami discloses a print size selecting means 51, which is key 6 (see
12 the bottom of FIG. 6 and also column 8, lines 31-43). This allows the user to
13 select an arbitrary image size (see Abstract, 3rd line and 2nd to bottom line). Thus,
14 Hanagami does not disclose using the recited factors to calculate a range of image
15 sizes.

16 The Patent Office suggests that Hanagami discloses in column 6, line 27 to
17 column 8, line 53 and column 19, line 59 to column 20, line 34 the factors recited.
18 The Applicant respectfully disagrees, and respectfully requests that the Patent
19 Office show the location of the factors and their impact on the calculation of
20 image sizes with more specificity. Again, the Hanagami image size is selected
21 arbitrarily, by user input of the millimeters (column 8, lines 31-37) or from a list
22 of country passport sizes (column 8, lines 38-43), and is not selected using the
23 recited factors of claim 9. Hanagami discloses no calculation, and therefore no
24 factors by which the calculation is made.
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1 Because the factors of claim 9 are not disclosed by Hanagami, the
2 Applicant respectfully requests that the rejection of claims 9 and 15 be removed,
3 and that these claims be allowed to issue.

4 Claims 10, 11 and 16 depend from Claim 1 and are allowable due to their
5 dependence from an allowable base claim. These claims are also allowable for
6 their own recited features that, in combination with those recited in Claim 1, are
7 neither disclosed nor suggested in references of record, either singly or in
8 combination with one another.

9 Claim 12 recites a method for printing an image comprising:

- 10
- 11 • receiving an image;
 - 12 • calculating a range of image sizes for printing said image based on a
13 plurality of factors; and
 - 14 • printing said image in a size in said range.

15 Claims 17 is similar. Both claims are allowable for most of the same
16 reasons as claim 1, and the arguments set forth in that section are incorporated
17 herein by reference. Accordingly, the Hanagami reference is deficient, and the
18 Applicant respectfully requests that the rejection of claims 12 and 17 be removed.

19 **The §103 Rejections**

20 Claims 4-8 and 21-22 were rejected as being unpatentable over Hanagami
21 in view of U.S. Pat. No. 6,587,221, hereinafter "Young."

22 The Applicant submits that the Office has failed to establish a *prima facie*
23 case of obviousness and, in view of the comments below, respectfully traverses the
24 Office's rejections. However, before discussing the substance of the Office's
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1 rejections, a section entitled "The §103 Standard" is provided and will be used in
2 addressing the Office's rejections.

3
4 **The §103 Standard**

5 To establish a *prima facie* case of obviousness, three basic criteria *must* be
6 met. First, there must be some suggestion or motivation, either in the references
7 themselves or in the knowledge generally available to one of ordinary skill in the
8 art, to modify the reference or to combine reference teachings. *In re Jones*, 958
9 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5
10 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation
11 of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.
12 1986). Finally, the prior art reference (or references when combined) must teach
13 or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580
14 (CCPA 1974).

15 Hence, when patentability turns on the question of obviousness, the search
16 for and analysis of the prior art includes evidence relevant to the finding of
17 whether there is a teaching, motivation, or suggestion to select and combine or
18 modify the references relied on as evidence of obviousness. The need for
19 specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371,
20 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to
21 the reason the skilled artisan, with no knowledge of the claimed invention, would
22 have selected these components for combination in the manner claimed").
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1 **Claim 4** recites method of claim 1, wherein said step of calculating further
2 comprises:

- 3 • determining an aspect ratio of said image; and
- 4 • calculating said range, whereby an image printed in each of said
5 sizes in said range has an aspect ratio approximately equal to an
6 aspect ratio of said received image.

7 **Claims 4** depends from Claim 1 and is allowable due to its dependence from
8 an allowable base claim. Moreover, nothing in the Young reference remedies the
9 deficiencies in the Hanagami reference with respect to the rejection of claim 1.
10 Accordingly, the rejection of claim 1 is still deficient, and claim 4 is allowable as
11 depending from an allowable claim.

12 Additionally, Young does not address, in the cited passage, the recited
13 elements of claim 4. For example, calculating the range, and other aspects of
14 claim 4, do not appear in Young. If the Patent Office persists in this rejection, the
15 Applicant respectfully requests that the basis of the rejection be more specifically
16 pointed out.

17 **Claim 5** recites method of claim 4, wherein said step of calculating further
18 comprises steps of:

- 19 • determining a resolution of said received image;
- 20 • determining a resolution of a printer printing said image;
- 21 • correlating said resolution of said received image and said printer;
22 and
- 23 • calculating said sizes in said range, whereby an image printed in
24 each of said sizes in said range has a resolution associated with said
25 correlated resolution.

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1 **Claim 5** depends from Claim 1 and is allowable due to its dependence from
2 an allowable base claim. Additionally, claim 5 recites detail of the calculation of
3 the sizes of the range. As seen above, Hanagami does not disclose calculation of
4 an image. Instead, Hanagami discloses that the image size may be selected to be
5 any arbitrary size.

6 Additionally, Hanagami fails to disclose a plurality of image sizes (the
7 range). More particularly, Hanagami fails to disclose a plurality of image sizes
8 wherein each size has a resolution associated with said correlated resolution. In
9 contrast, Hanagami discloses a single image size.

10 Because the elements of claim 5 are not disclosed by Hanagami, the
11 Applicant respectfully requests that the rejection of claim 5 be removed, and that
12 this claim be allowed to issue.

13 **Claims 6, 7 and 8** depend from Claim 1 and are allowable due to their
14 dependence from an allowable base claim. These claims are also allowable for
15 their own recited features that, in combination with those recited in Claim 1, are
16 neither disclosed nor suggested in references of record, either singly or in
17 combination with one another. Generally, Hanagami fails to disclose the step of
18 calculating a range of image sizes. More particularly, Hanagami fails to disclose
19 calculating a range of image sizes according to the detail recited in claims 6 and 7.
20 Instead, Hanagami discloses selection of any arbitrary size for the image, without
21 calculation. Moreover, Hanagami discloses selection of a single image size, and
22 not a range.

23 The Patent Office suggests that the elements of claims 6, 7 and 8 are shown
24 in column 6, line 27 to column 8, line 53 and column 19, line 59 to column 20,
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1 line 34. However, the Applicant fails to see the recited elements disclosed, and
2 respectfully asks the Patent Office to more particularly point them out if the
3 rejection is maintained.

4 **Claims 21 and 22** depend indirectly from Claim 17 and are allowable due
5 to their dependence from an allowable base claim. These claims are also
6 allowable for their own recited features that, in combination with those recited in
7 the claims from which they depend, are neither disclosed nor suggested in
8 references of record, either singly or in combination with one another.

9
10 **Conclusion**

11 The Applicant submits that all of the claims are in condition for allowance
12 and respectfully requests that a Notice of Allowability be issued. If the Office's
13 next anticipated action is not the issuance of a Notice of Allowability, the
14 Applicant respectfully requests that the undersigned attorney be contacted for the
15 purpose of scheduling an interview.

16
17 Respectfully Submitted,

18 Dated: 4-8-05

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